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IN THE

Supreme Court of the United States

October Term, 1948

No. 372

LEROY J. LEISHMAN,

Petitioner,

vs.

RADIO CONDENSER COMPANY and GENERAL INSTRUMENT CORPORATION,

Respondents.

Brief for Respondents in Reply to Petition for Rehearing of Order on Petition for Writ of Certiorari.

Since the denial of the original Petition for Writ of Certiorari by petitioner there has been no change whatsoever respecting the instant case. A rehearing was granted by the Court of Appeals for the Tenth Circuit in the case of *The Richards and Conover Company v. LeRoy J. Leishman,* Appeal No. 3577, wherein the original decision has now been reported in — F. 2d —, 79 U. S. P. Q. 316. After such rehearing, the Court of Appeals for the Tenth Circuit reaffirmed its prior decision and on January 20, 1949 filed an opinion on the rehearing, which opinion has not yet been reported but which is set forth in the Appendix hereto. In this opinion, the Court adheres to its position that the asserted claims of the patent in suit do not define invention over the prior art.

Argument.

There are no questions presented in the instant petition which were not raised by petitioner in his original petition. Nevertheless, petitioner again urges that a conflict of opinion exists between the Courts of Appeals for the Ninth and Tenth Circuits, and that since the denial of his original petition this Court has rendered an opinion in the case of *Jungersen v. Ostby and Barton Company et al., Ostby and Barton Company et al. v. Jungersen, Jungersen v. Baden et al.*, — U.S. —, — S.Ct. —, 93 L.Ed. 232, 80 U.S.P.Q. 32, which supports his position that certiorari should be granted in the instant case.

However, the *Jungersen* case did not involve a mere asserted conflict of opinion but rather represented a conflict of decision. In that case, while in both the Second and Third Circuits claims 5 and 6 of the Jungersen patent had been held invalid, the Court of Appeals for the Second Circuit held claims 1 through 4 invalid but the Court of Appeals for the Third Circuit held said claims 1 through 4 valid but not infringed. Thus a square conflict existed between the two Circuits as to the validity of said claims 1 through 4 and as stated by this Court (93 L.Ed. at 234): ". . . the sole issue before us is the validity of the patent."

As pointed out by respondents in their prior brief, no conflict of decision exists in the instant case. In *Leishman v. Associated Wholesale Electric Co.*, 137 F. 2d 722, followed in the instant case, the Court of Appeals for the Ninth Circuit held petitioner's patent not infringed and thereafter stated

> "The judgment declares that the claims 'are invalid for want of invention.' In the view we take, the declaration is unnecessary. As to its correctness or incorrectness, we express no opinion." (page 727)

In *The Richards and Conover Company v. LeRoy J. Leishman, supra,* the Court simply refused to dispose of the case on the ground of infringement, but rather based its decision upon the more important ground that petitioner's patent is invalid.

Thus, despite petitioner's assertions, no conflict of opinion is present herein; but even were such conflict present, in the absence of actual conflict of decision, certiorari will not be granted under the practice of this Court.

Respectfully submitted,

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LEONARD S. LYON, JR.,
Attorneys for Respondents.

MAXWELL JAMES,
Of Counsel.

APPENDIX.

IN THE

United States Court of Appeals

FOR THE TENTH CIRCUIT

No. 3577 – November Term, 1948

THE RICHARDS AND CONOVER COMPANY, a corporation,

Appellant,

vs.

LEROY J. LEISHMAN,

Appellee.

Appeal from the United States District Court for the Western District of Oklahoma.

OPINION ON REHEARING.

Filed Jan. 20, 1949. Robert B. Cartwright, Clerk.

Foorman L. Mueller for appellant.

LeRoy J. Leishman pro se. (John Flam on the brief on rehearing.)

Before Phillips, Chief Judge, and Bratton and Huxman, Circuit Judges.

Phillips, Chief Judge, delivered the opinion of the court.

In our former opinion, we recognized the importance of coaxiality between the axis of the rocker shafts and the

axis of the pin on which the tappet is mounted on the lever or plunger. We said:

> "This coaxial relationship is important because it insures accuracy at the time of the adjustment of the tappet. When each side of the tappet is brought into engagement with its corresponding arm of the rocker, the latter having been set at a predetermined and desired position, with coaxiality between the axis of the tappet and the axis of the rocker, pressure on the lever to hold the tappet in engagement with the rocker while the setscrew is being tightened [to hold the tappet in a desired position] will not result in movement of the rocker. Absent such coaxiality, pressure on the lever bringing the tappet into full engagement with the rocker, when the latter is in certain angular positions, would have a tendency to move the rocker."

Such movement of the rocker is called creeping.

We held, however, that the ascertainment of the cause of creeping in the Marschalk device and the making of the changes in that device necessary to overcome creeping would involve the exercise of mere mechanical skill and would not amount to invention.

On rehearing, counsel for Leishman urged that the cause of creeping in Marschalk's device is obscure; and that neither such cause nor the solution of the problem would readily occur to a mechanic skilled in the art.

Our views with respect to such contention may be more readily expressed by reference to the following drawings:

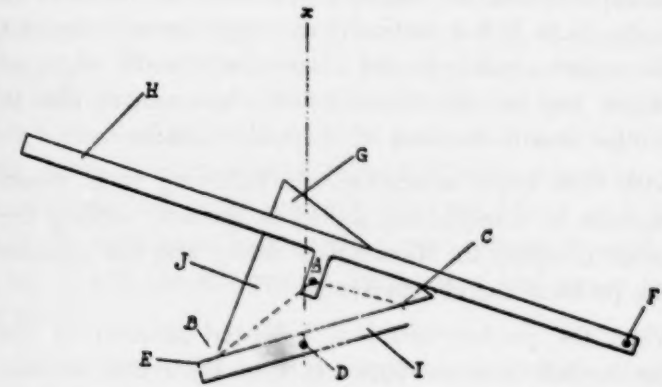

Fig.- 1

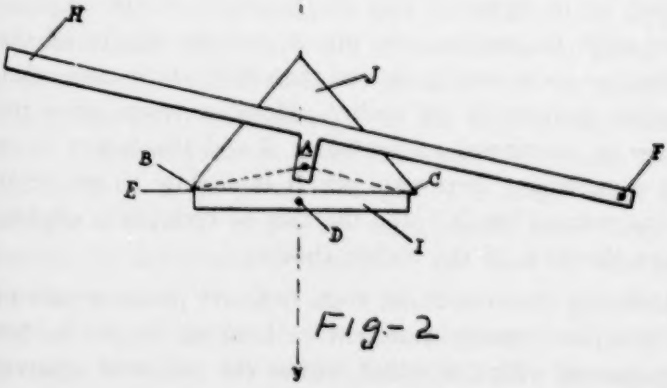

Fig.- 2

I is a view of one end of the rocker; D is the shaft at one end of the rocker, which is carried by a journal in the frame; H is the lever, one end of which is pivotally

attached to the frame at F. An arm extends downward from the lever and the tappet J is pivoted on that arm by a pin A. X to Y is a vertical line drawn through the axis of the rocker shafts; E and C are the opposite edges of the upper face of the rocker, which edges run parallel to each other and to the axis of the rocker shafts.

With little experimentation, the following facts would be obvious to a mechanic, skilled in the art, seeking the cause of creeping in Marschalk's device and the solution of the problem thereby presented.

When the predetermined and desired position of the rocker is such that the upper face of the rocker is substantially at right angles with the vertical line XY, as in figure 2, downward pressure on the lever H sufficient to hold the tappet in full engagement with the rocker will not cause creeping. Indeed, when the rocker is in that position, very heavy downward pressure on the lever will not cause perceptible creeping. When the rocker is positioned, as in figure 2, and the tappet is in full engagement with the rocker, the pin A and the shafts of the rocker are more nearly coaxial than they are in any other possible position of the rocker. However, even when the rocker is positioned as in figure 2 and the tappet is in full engagement therewith, pin A is slightly to the right of the vertical line XY and the axis of such pin is slightly above the axis of the rocker shafts.

Creeping does not result from ordinary pressure exerted on the lever, amply sufficient to hold the tappet in full engagement with the rocker, unless the rocker is substantially tilted, that is, positioned so that one side is substantially above the other as in figure 1.

When the rocker and the tappet are positioned as in figure 1, pin A is a greater distance above the axis of

the rocker shafts and a greater distance to the right of the vertical line XY than when the rocker and tappet are positioned as in figure 2. In other words, the more the rocker is tilted, the greater becomes the non-coaxiality between the axis of the rocker shafts and pin A. And when the rocker and tappet are positioned as in figure 1, the vertex G of the tappet, instead of being approximately at the line XY, as in figure 2, is to the left of such line, and the right-hand base of the tappet extends beyond the edge C and the left end of the base of the tappet is at point B.

When the rocker and the tappet are positioned as in figure 1, the distance from pin A to point B on the upper face of the rocker is greater than the distance from pin A to the point on edge C of the upper face of the rocker where the base of the tappet intersects such edge, referred to hereinafter as point O. And the distance from the axis of the rocker shafts to the point on edge C of the upper face of the rocker where the base of the tappet intersects such edge, referred to hereinafter as point P, is greater than the distance from such axis to point B. Hence, the lever from point P to the axis of the rocker shafts is longer than the lever from point B to such axis, and the lever from point B to pin A is longer than the lever from point O to pin A. As a result, when force is exerted by downward pressure of the lever H through the tappet upon the upper face of the rocker, the downward force at point O has the advantage of greater leverage than the downward force at point B, and the resisting force of the rocker at point B has the advantage of greater leverage than the resisting force of the rocker at point O. Consequently, when the tappet and the rocker are positioned as in figure 1, and lever H is

pressed downward, edge E will move upward and edge C will move downward until the corresponding leverages are approximately equal as in figure 2.

Since the more the rocker is tilted the greater becomes the non-coaxiality between the axis of the rocker shafts and pin A and the greater becomes the tendency of the rocker to creep, and since, when the pin A approaches substantial coaxiality with the rocker shafts, creeping disappears, it is obvious that the problem can be solved by effecting substantial coaxiality between pin A and the axis of the rocker shafts, when the tappet is in full engagement with the rocker. When such coaxiality is effected, the distance between pin A and point O and between pin A and the point where the base of the tappet intersects edge E, will be equal, and the distance between point P and the axis of the rocker shafts, and between such axis and the point where the left-hand base of the tappet intersects edge E, will be equal, when the tappet is brought into full engagement with the rocker, regardless of the position of the rocker.

Such coaxiality can be effected by lengthening the arm on the lever H, extending an arm from the center of the base of the tappet, cutting a rectangular opening in the rocker sufficient to admit the arm on the lever H and the arm of the tappet, positioning the tappet in full engagement with the parallel arms of the rocker and then attaching the arm of the tappet pivotally to the arm of the lever H by pin A, at a point coaxial with the axis of the rocker shafts.

The solution of the problem would be less difficult in a device which employs a plunger to which the tappet is pivotally attached and which moves the tappet into engagement with the rocker because, in such types, there normally would be an opening in the rocker through which one end of the plunger would move and the pin which carries the tappet on the plunger would move in a straight line rather than in an arc as in the lever type.

Counsel for Leishman contend it is manifest that the cause of creeping is obscure because an expert witness for the defendant below testified that if the line of thrust from pin A is either to the left or the right of the axis of the rocker shafts, creeping will occur, and that Leishman's physical exhibits 26, 26A, 26B, and 26C demonstrate that if pin A is not coaxial with the rocker shafts, although the pin travels downward in a line of thrust which intersects the axis of the rocker shafts, creeping will still result.

It is obvious that when the expert so testified, he was talking about a force from pin A traveling along a straight line. In Marschalk's device, pin A travels in an arc. But the fact that pin A moves in an arc to the right of vertical line XY is one cause of the creeping in Marschalk's device. The expert did not testify that it was the sole cause of creeping. Indeed, he testified that where the rocker is mounted on a rotatable shaft, rather than as in the prior patent to Schaefer No. 1906106,[1] substantial

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[1]Schaefer, instead of using rockers, employed pairs of vertically disposed, reciprocable racks, which moved in guides by means of levers and tappets.

coaxiality between the axis shafts and pin A would be necessary to avoid creeping.

For the reasons indicated, we adhere to the views expressed in our former opinion that the inclusion of the element of coaxiality in claims 8, 10, and 11 of the patent in suit did not rise to the dignity of invention over Marschalk and other prior disclosures.

The Judgment is REVERSED and the cause REMANDED with instructions to enter a decree adjudging the claims in suit invalid for want of invention.

A true copy,

TESTE:

[Seal] ROBERT B. CARTWRIGHT,
Clerk.